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Charles Eric Hunter

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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

AUGUSTIN, EVENS J

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/476,078
Filing Date: December 30, 1999
Appellant(s): HUNTER, CHARLES ERIC

MAILED

JUL 14 2008

GROUP 3600

Kenneth E. Plochinski

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04 March 2008 appealing from the Office action mailed 22 June 2007.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/707,273

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5572442	Schulhof et al.	11-1996
6272636	Neville et al.	8-2001

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-9 and 32-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

4. In this particular case, the information is not coming directly from the station such that the step does not require a tie to another statutory category, but even if it did, Examiner has considered merely gathering of data with a machine to be nominal.

Claim Rejections - 35 USC § 103

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.

7. Claim 1-28, 30 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al., U.S. Patent No. 5,572,442 in view of Neville et al., U.S. Patent No. 6,272,636.

a. As per claims 1-28, 30 and 31-33, Schulhof et al. teach a method for distributing music comprising:

- i. blanket transmitting, at faster than real time speeds, simultaneously a plurality of music selections to a plurality of customer households for receipt on a plurality of inputs (figures 1 and 5-7; column 5, lines 50-60)
- ii. a first interface enabling at least one customer to preselect and record transmitted music selections in a read/write storage medium (e.g. read/write CDs, magneto-optical disks, digital tape) (abstract; figures 1, 4, and 6; column 5, lines 6-20 and 50-67; column 7, lines 5-53; column 8, lines 60-67; column 12, lines 54-67)
- iii. a second interface permitting the customer to select recorded music for unrestricted playback (figures 1, 4, and 6; column/line 4/48-5/20; column 5, lines 50-67; column 7, lines 5-53; column 9, lines 20-26)
- iv. communicating unrestricted playback selection information to a central controller, via satellite, cable,...etc., and billing the customer

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- v. for the selected unrestricted playback (column/line 4/48-5/20; column 6, lines 24-52; column/line 7/54-8/2; column 9, lines 20-26; column 10, lines 42-65)
- vi. selection information that includes availability, scheduling and price data (column 5, lines 60-64; column 7, lines 27-33 and 45-53; column/line 7/61-8/4; column 9, lines 26-38) an interactive guide, via a display device, to allow users to make content selections, and select functions to playback and record content (abstract; figures 1-4, 6 and 7; column 7, lines 27-53; column/line 9/65-10/15; column/line 11/65-12/10; column 12, lines 54-67; column 13, lines 10-28; column 14, lines 18-26 and 39-55)
- vii. receiving and decoding musical selections and storing decoded selections and associated information in a digital data storage
- viii. device for temporary storage (figures 2, 3 and 7; column 9, lines 26-38; column 12, lines 10-18 and 29-67)
- ix. accessing the content over the internet link to a website or phone line connection (figure 1; column 7, lines 35-52)
- x. allowing users to access content one or more times on a no-charge basis prior to permanently selecting the content (column 9, lines 27-37)
- xi. generating a permanent enabling code for inclusion with the permanent recorded music selections to enable unrestricted playback (column 9, lines 27-37)
- xii. communicating with a broadcast satellite up-link facility, operating in the KU or other suitable frequency bands, via a central controller,

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xiii. and transmitting program/pricing information to the broadcast facility on a periodic basis (figures 5 and 7; column 6, lines 24-52)

8. Schulhof et al. teach a system for transmitting audio content to a plurality of users, where users can record and playback content using a plurality of interfaces, and are billed for using the content distribution service (figures 1 and 4-7; column/line 4/48-5/67; column 6, lines 24-34; column/line 7/54-8/2). Schulhof et al. do not specifically recite using DVD-RAM to record content. However, Schulhof et al. teach that digital, optical, magnetic or other high density, high capacity can be used. Therefore, it would have been obvious to one of ordinary skill to use DVD-RAM for portable storage (column 4, lines 55-67; column 8, lines 59-67; column 12, lines 54-64). Similarly it would have been obvious to one of ordinary skill to store a plurality of disks with content recorded thereon.

9. However, Schulhof et al. do not specifically recite “permitting the at least one customer household to select previously recorded music selections, that were previously recorded by the at least one customer household in the storage medium for unrestricted playback”, nor does Schulhof et al. teach generating enabling codes subsequent to the recording of music wherein said codes enable unrestricted playback. Neville et al. teach allowing users to access content stored on a user device on a trial basis, then sending an enabling code to allow further use of the previously recorded product after the trial period had expired (abstract; column 13, lines 5-44). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Schulhof et al. and Neville et al. to allow consumers to evaluate a fully functional product while

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protecting content providers from malicious use on the part of the consumer ('442, column 9, lines 27-37; '636, column/line 1/35-5/35).

(10) Response to Argument

Argument: Prior art do not teach the aspect of “unrestricted playback selection information having been generated automatically”

Response: The aspect of “unrestricted playback selection information having been generated automatically” is not the same as a selecting step being done automatically. Selection information, interpreted broadly, can be a notice to make a selection or any other information about the selection. In this case, Neville et al. (“Neville”) teach allowing users to access content stored on a user device on a trial basis, then sending an enabling code to allow further use of the previously recorded product after the trial period had expired (abstract; column 13, lines 5-44). As appellant correctly stated on page 11 of the brief, Neville presents a message to the user indicating the trial evaluation has terminated and that purchase is now purchase (Column 9, Lines 46-53). The metering/tracking of the evaluation period and the messaging to the user happen automatically.

Additionally, once the selection is made, the user does not transport it to the server, and does not generate the type of information/code that the server gets back from the user as part of the selection. Therefore, selection information is generated automatically. It is generated by the system, and not by the user.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent

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applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Evens J. Augustin /EA/

Examiner 3621

June 23, 2008

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

/Jalatee Worjloh/

Primary Examiner, Art Unit 3685

Vincent Millin /VM/

Appeals Conference Specialist

Art Unit: 3600

Calvin Hewitt

Supervisor, Art Unit 3685

Evens Augustin

Katherine Matecki

APPROVED BY DIRECTOR
KATHERINE MATECKI